

REMARKS

I. Status of the Claims

Claims 1–4, 6–25, 28–33, and 36–38 are present in the application and pending on the merits. By this Amendment, claims 1, 29, 37, and 38 have been amended. No new matter has been added. Claims 26, 27, 34, 35, and 39 have been canceled without prejudice or disclaimer.

Applicant appreciates the Examiner's allowance of claim 36. Office Action at 6. For at least the reasons outlined herein, Applicant respectfully requests reconsideration and withdrawal of the claim objection and claim rejections, and allowance of pending claims 1–4, 6–25, 28–33, 37, and 38.

II. Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action, claims 1–4, 6, 13–18, 26, 27, 29, 30, 34, 37, and 39 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 3,754,712 to Cecil (Cecil). Office Action at 2. In addition, claims 23–25 and 33 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 5,718,756 to Mohler (Mohler). Id. Claim 28 was rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 3,309,214 to Joseph et al. (Joseph). Id. at 3. Claims 7, 8, and 10–12 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 4,423,118 to Corbett et al. (Corbett). Id. Claims 7–10, 31, 32, and 38 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 5,799,978 to Grinnell (Grinnell) and U.S. Patent No. 4,716,186 to Portnoy et al. (Portnoy). Id. Claims 19–22 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with U.S. Patent No. 6,171,702 to Malhotra et al. (Malhotra), “as evidenced by” U.S. Pat. App. No. 2001/0051230 to

Colton et al. (Colton) "and/or" U.S. Patent No. 4,686,260 to Lindemann et al.

(Lindemann). Id.

Applicant respectfully submits that the rejected claims, as amended, are patentably distinguishable from the references relied on in the claim rejections, and requests reconsideration and withdrawal of the claim rejections for at least the reasons outlined below.

A. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil

Claims 1–4, 6, 13-18, 26, 27, 29, 30, 34, 35, 37, and 39 were rejected under 35 U.S.C. § 103(a) based on Cecil. Office Action at 2. Claim 39 has been canceled without prejudice or disclaimer, rendering the rejection of that claim moot. Presently amended claims 1, 29, and 37 are the only pending independent claims included in that claim rejection, and Applicant respectfully submits that those claims are patentably distinguishable from Cecil for at least the reasons outlined below.

Cecil discloses kaolin clay that has undergone grinding/ball milling, as noted in Applicant's Request for Reconsideration filed January 29, 2009, in response to the final Office Action dated August 29, 2008 (Request for Reconsideration).¹ In the "Response to Arguments" section, the Office Action notes that "Applicant's arguments filed January 29, 2009[,] with respect to the prior art, specifically, Cecil disclosing the use of ball milling (i.e. mechanical milling) have been fully considered, and found persuasive" Office Action at 3. Independent claims 1, 29, and 37, as amended, are patentably

¹ Request for Reconsideration at 8 ("Cecil discloses kaolin clay that has undergone grinding/ball milling. See, e.g., Cecil at col. 6, ll. 29–33 (claiming a method requiring "wet milling said suspension in the presence of grinding media having a specific gravity above 3 until the viscosity of the clay is reduced sufficiently to permit the addition of more clay without stopping the mill"); Cecil at col. 6, ll. 48–52 (claiming a method requiring "ball milling the resulting slurry with ceramic milling media having a specific gravity above 3 until the viscosity of the suspension is reduced, adding increments of calcined clay, each increment being followed by further ball milling")").

distinguishable from Cecil at least because all of those claims recite that “the calcined kaolin has not been subjected to mechanical grinding.” Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of those independent claims under § 103(a) based on Cecil.

Claims 2–4, 6, 13–18, and 30 (claims 26, 27, 34, 35, and 39 have been canceled) each depend from a corresponding one of independent claims 1 and 29. For at least this reason, claims 2–4, 6, 13–18, and 30 should be patentably distinguishable from Cecil, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims under § 103(a) based on Cecil.

B. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Mohler

Claims 23–25 and 33 were rejected under 35 U.S.C. § 103(a) based on Cecil in combination with Mohler. Office Action at 2. Claims 23–25 and 33 depend respectively from independent claims 1 and 29. Thus, claims 23–25 and 33 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claims 1 and 29. See supra Part II.A. Moreover, Mohler fails to overcome the above-outlined deficiencies of Cecil, and thus, Cecil and Mohler, regardless of whether they are viewed individually or as a whole, fail to render claims 23–25 and 33 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 23–25 and 33 under 35 U.S.C. § 103(a) based on Cecil and Mohler.

C. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Joseph

Concerning the rejection of claim 28 under 35 U.S.C. § 103(a) based on Cecil in combination with Joseph, claim 28 depends from independent claim 1. Thus, claim 28 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. See supra Part II.A. Moreover, Joseph fails to overcome the above-outlined deficiencies of Cecil, and thus, Cecil and Joseph, regardless of whether they are viewed individually or as a whole, fail to render claim 28 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claim 28 under 35 U.S.C. § 103(a) based on Cecil and Joseph.

D. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Corbett

Concerning the rejection of claims 7, 8, and 10–12 under 35 U.S.C. § 103(a) based on Cecil in combination with Corbett, claims 7, 8, and 10–12 depend from independent claim 1. Thus, those claims should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. See supra Part II.A. Moreover, Corbett fails to overcome the above-outlined deficiencies of Cecil. Thus, Cecil and Corbett, regardless of whether they are viewed individually or as a whole, fail to render claims 7, 8, and 10–12 prima facie obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 7, 8, and 10–12 under 35 U.S.C. § 103(a) based on Cecil and Corbett.

**E. Claim Rejection under 35 U.S.C. § 103(a) based on
Cecil in view of Grinnell and further in view of Portnoy**

Concerning the rejection of claims 7–10, 31, 32, and 38 under 35 U.S.C. § 103(a) based on Cecil in combination with Grinnell and Portnoy, claims 7–10, 31, and 32 depend from a corresponding one of independent claims 1 and 29. Thus, claims 7–10, 31, and 32 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claims 1 and 29. *See supra* Part II.A. Moreover, Grinnell and Portnoy fail to overcome the above-outlined deficiencies of Cecil. For at least this reason, Cecil, Grinnell, and Portnoy, regardless of whether they are viewed individually or as a whole, fail to render claims 7–10, 31, and 32 *prima facie* obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 7–10, 31, and 32 under 35 U.S.C. § 103(a) based on Cecil, Grinnell, and Portnoy.

Independent claim 38 is directed to a method of making a coated paper or coated paper board, including, *inter alia*, “coating a fibrous substrate with slurry, the slurry comprising calcined kaolin wherein . . . the calcined kaolin has not been subjected to mechanical grinding.” Thus, independent claim 38 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. *See supra* Part II.A. Moreover, Grinnell and Portnoy fail to overcome the above-outlined deficiencies of Cecil. Thus, Cecil, Grinnell, and Portnoy, regardless of whether they are viewed individually or as a whole, fail to render independent claim 38 *prima facie* obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 38 under 35 U.S.C. § 103(a) based on Cecil in combination with Grinnell and Portnoy.

F. Claim Rejection under 35 U.S.C. § 103(a) based on Cecil in view of Malhotra “as evidenced by” Colton “and/or” Lindemann

Concerning the rejection of claims 19–22 under 35 U.S.C. § 103(a) based on Cecil in combination with Malhotra “as evidenced by” Colton “and/or” Lindemann, claims 19–22 depend from independent claim 1. Thus, claims 19–22 should be patentably distinguishable from Cecil for at least the reasons outlined above with respect to independent claim 1. See supra Part II.A. Moreover, Malhotra (even “as evidenced by” Colton “and/or” Lindemann) fails to overcome the above-outlined deficiencies of Cecil. Thus, Cecil, Malhotra, Colton, and Lindemann, regardless of whether they are viewed individually or as a whole, fail to render claims 19–22 obvious. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 19–22 under 35 U.S.C. § 103(a) based on Cecil in combination with Malhotra “as evidenced by” Colton “and/or” Lindemann.

III. Claim Objection Under 37 C.F.R. § 1.75

In the Office Action, claim 35 was objected to under 37 C.F.R. § 1.75 as “being a substantial duplicate of claim 36.” Office Action at 6. Claim 35 is canceled herein, rendering this objection moot. As such, Applicant respectfully requests withdrawal of this objection.

IV. Conclusion

For at least the above-outlined reasons, Applicant's independent claims 1, 29, and 36–38 should be allowable. Dependent claims 2–4, 6–25, and 28 depend from allowable independent claim 1. Consequently, those dependent claims should be allowable for at least the same reasons independent claim 1 is allowable. Dependent claims 30–33 depend from allowable independent claim 29. Thus, those dependent

claims should be allowable for at least the same reasons independent claim 29 is allowable.

For at least the above-outlined reasons, Applicant respectfully requests reconsideration of this application, withdrawal of the claim objection and claim rejections, and allowance of all of pending claims 1-4, 6-25, 28-33, and 36-38.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned representative at (404) 653-6553.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Amendment, and charge any additional fees to Deposit Account 06-1916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Date: June 3, 2009

By: 

Alexis N. Fairweather
Reg. No. 63,686